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MAY 01 2007

Appl. No. 10/730,433

ACH2977US

Request For Continued Examination dated May 1, 2007

Reply to Office Action of November 1, 2006

REMARKS

Claims 1 - 10 are in the case. All claims stand rejected. Claims 1 and 7 have been amended to include as a limitation of the claims that the pore size distribution of catalyst I inhibits sediment formation and promotes asphaltene removal, and that the pore size distribution of catalyst II provides catalytic activity and inhibits sediment formation.

With regard to the Examiner's comments in the Final office action related to *In re Fulton* as authority for the Examiner's basis for establishing the proper motivation to combine necessary for establishing a prima facie case of obviousness, the Applicants submit that the Examiner reliance on *Fulton* in support of his argument is misplaced.

In *Fulton*, the claim in question dealt with an improved shoe sole having, in addition to other limitations, hexagonal shaped projected surfaces oriented in a particular direction for increasing the resistance to slip on a contact surface. *Fulton* at 1196-1197. One prior art reference recited all of the limitations of the patentee's claim except for the hexagonal shaped projected surface. While not specifically mentioning hexagonal shaped projected surfaces, the reference suggested that "cylindrical polygon shaped projections other than those expressly described (square, rectangular or triangular) may be employed...for good traction." *Fulton* at 1199. Another prior art reference disclosed hexagonal shaped projected surfaces oriented in the same particular direction as in the patentee's claim. The patentee argued that the second prior art reference did not disclose that hexagonal shaped projected surfaces are preferred over other alternatives disclosed in the prior art. The court ruled, however, that the "case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention." *Fulton* at 1200.

The holding in *Fulton* cannot be applied to the instant application. In *Fulton*, the patentee's claim and the prior art were all related to shaped projections on shoe soles. The functionality of such projections could only be related to traction. So, it is easy to see how the prior art in *Fulton* as a whole provided the requisite motivation to combine.

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To the contrary, such motivation cannot be found in the art cited by the Examiner (Kramer and Schindler).

Claim 1 of the instant application recites among other limitations, a catalyst system comprising one catalyst whose function is to permit deposition of metals and asphaltenes (deposition catalyst), and a second catalyst whose function is to provide catalytic activity (activity catalyst). The Examiner has already agreed that Kramer does not disclose Applicants' deposition catalyst. However, the Examiner suggests that one skilled in the art would be motivated to substitute the catalyst disclosed in Schindler for the deposition catalyst disclosed in Kramer to arrive at the Applicants' invention because Schindler discloses that his catalyst has "improved hydrotreating activity and improved catalyst life." This simple statement has nothing to do with the functionality of neither Kramer's nor Applicants' deposition catalyst whose function is to permit deposition of metals and asphaltenes. If Schindler provides any motivation at all, it would be to substitute Schindler's catalyst for Kramer's or the Applicants' activity catalyst, whose function is to provide catalyst activity. Since such a combination would not comprise all of the limitations of Applicants' Claim 1, it cannot be used as a prima facie case for obviousness.

Without any motivation to combine Schindler with Kramer, Applicant submits that claim 1 is in condition for allowance, as are all claims that depend on claim 1. Further, Applicant submits that claim 7, as well as any claim that depends on claim 7, is in condition for allowance for the same reason as outlined above.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Examiner is encouraged to contact Applicants' attorney should the Examiner wish to discuss this application further.

Respectfully submitted,

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